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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91125743
Party	Plaintiff THE SERVICEMASTER COMPANY ,
Correspondence Address	P. JAY HINES OBLON, SPIVAK, MCCLELLAND 1940 DUKE STREET ALEXANDRIA, VA 22314
Submission	Motion for Protective Order
Filer's Name	P. Jay Hines
Filer's e-mail	phines@oblon.com, acahill@oblon.com, tmdocket@oblon.com
Signature	/P. Jay Hines PJH/ASC/
Date	12/16/2004
Attachments	motforpo.PDF (27 pages)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the consolidated proceeding, Opposer objects to the registration of SERVICEMARK, U.S. Appln. Serial No. 76/166,568, and SERVICEMARK HEATING COOLING PLUMBING (& Design), U.S. Appln. Serial No. 76/237,328 and Registration No. 2,591,190, for use in connection with sales, repair and maintenance of HVAC and plumbing equipment, on the basis of Opposer's longstanding registration of and common law rights in the SERVICEMASTER marks of U.S. Registration Nos. 1,220,269 and 1,272,228 ("the SERVICEMASTER marks"), for identical and overlapping goods and services.

Applicant originally served on Opposer a Notice to Take Deposition of Opposer's Chairman and Chief Executive Officer Jonathan P. Ward. After Opposer filed a Motion for Protective Order to prevent the discovery deposition of its highest ranking chief executive from going forward, Applicant agreed to withdraw its notice and, in exchange, Opposer agreed to withdraw its motion seeking Board intervention by Stipulation filed September 28, 2004.

On October 8, 2004, Applicant's counsel noticed the deposition of AMS President Ed Dunn for October 28, 2004. A copy of Mr. Dunn's Notice of Deposition is attached hereto as Exhibit A. Opposer, The ServiceMaster Company, is the parent company of AMS and has entered licensing agreements by which AMS is authorized to use the SERVICEMASTER marks in connection with various goods and services, some of which are at issue in the consolidated proceeding.

President Dunn serves primarily as Chief Executive of Opposer's related company AMS, and as such, is generally familiar with the SERVICEMASTER marks and of the goods and services offered and sold by Opposer under the SERVICEMASTER marks through its related company AMS. However, Mr. Dunn does not have unique, specialized first hand knowledge regarding the selection and adoption of the SERVICEMASTER marks, the marketing or legal

enforcement efforts regarding the SERVICEMASTER marks, or of the various licensing terms which govern the use of the SERVICEMASTER marks.

Opposer has identified at least three other employees as persons most knowledgeable of the facts at issue, namely Douglas Colber, Esq., Vice President, Assistant Secretary, and Legal Counsel; Sherry Campbell, former Trademark Manager, Legal Department; and Mitchell T. Engel, Chief Marketing Officer (“Mr. Engel”). Indeed, Opposer has offered Mr. Engel, one of the highest ranking officers in the company, to testify as both a Rule 30(b)(6) representative and as an individual witness. Mr. Engel’s deposition took place on November 10, 2004.¹

Upon receipt of the Notice of Deposition, and in an attempt to resolve this matter, counsel for Opposer contacted counsel for Applicant by correspondence dated October 21, 2004, noting that Mitchell T. Engel, Chief Marketing Officer of Opposer ServiceMaster, was the most knowledgeable witness and offering to substitute Mr. Engel in the place of President Dunn. A copy of Opposer’s correspondence dated October 21, 2004 is attached as Exhibit B.²

Applicant’s counsel, in response, agreed to proceed with a deposition of Mr. Engel as Rule 30(b)(6) representative and conducted the deposition on November 10, 2004. However, Applicant continued to assert its alleged right to depose Mr. Dunn, or to notice the depositions of additional witnesses for Philadelphia, Pennsylvania, should Applicant judge Mr. Engel’s testimony to be insufficient. A copy of Applicant’s counsel’s November 1, 2004 correspondence is attached hereto as Exhibit C.

In response, Opposer filed this Motion for Protective Order.

¹ Mr. Engel’s deposition was previously scheduled in October, but was cancelled unilaterally by Applicant’s counsel on the day prior.

² Opposer has since offered to make American Residential Services’ Mark Burel available as a witness.

ARGUMENT

Trademark Rule 2.120(f) and Rule 26(c) of the Federal Rules of Civil Procedure grant the Board discretion, upon a showing of good cause, to fashion an order limiting discovery, where justice so requires, to protect a party or person from annoyance, embarrassment, oppression or undue burden or expense. Among the forms of relief the Board may grant is an Order that a deposition not be had. Rule 26(c), Fed. R. Civ. P. and Trademark Rule 2.120(f).

The Board clarified its position in *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759 (TTAB 1999), that the unnecessary depositions of high level executives constitute the form of harassing conduct that the Federal Rules of Civil Procedure and the Trademark Rules of Practice were crafted to prevent. In the *FMR* case, the Board considered the noticed depositions of two “high level” officers of Opposer FMR Corporation. The Board noted that the officers were not identified by the moving party as persons with relevant knowledge of the issues presented by the Opposition, and that several other potential witnesses had, in fact, been offered by Opposer in place of the improperly named deponents.

The Board noted in issuing a protective order that, “[v]irtually every court which has addressed the subject [of depositions of high-level executives] has observed that the deposition of an official at the highest level or ‘apex’ of corporate management creates a tremendous potential for abuse and harassment.” *Id.* at 1762. The Board’s decision not to permit the depositions of Opposer’s high level executives to go forward was based on its findings that (1) the named deponents lacked unique or specialized personal knowledge of the relevant facts, and (2) the Applicant had attempted to “start at the top” prior to exhausting less intrusive and burdensome measures of obtaining the same discovery. *Id.* at 1762, citing *Salter v. Upjohn Co.*, 593 F.2d 649 (5th Cir. 1979).

The Board, expressly adopting the burden shifting analysis articulated in *Salter*, wrote:

[w]hen a party seeks to depose a very high-level official of a large corporation, and that official (or corporation) files a motion for protective order to prohibit the deposition, the movant must demonstrate through an affidavit or other evidence that the official has no direct knowledge of the relevant facts or that there are other persons with equal or greater knowledge of the relevant facts. If the movant meets this initial burden, then the burden shifts to the party seeking the deposition to show that the official has unique or superior personal knowledge of the relevant facts. If the party seeking the deposition does not satisfy this showing, then the Board will grant the motion for protective order and require that the party seeking the deposition attempt discovery through less intrusive methods.

FMR Corp. v. Alliant Partners at 1763. The same test has been applied by a number of courts in forbidding the depositions of high level executives to proceed. *See Baine v. General Motors Corp.*, 141 F.R.D. 332 (M.D. Ala. 1991) (deposition of Vice-President of General Motors denied as “oppressive, inconvenient and burdensome” unless plaintiffs first deposed lower level employees, the corporate representative, and propounded written interrogatories) and *Mulvey v. Chrysler Corp.*, 106 F.R.D. 364 (D.R.I. 1985)(Plaintiffs denied deposition of Chairman of Chrysler because he was “a singularly unique and important individual who can be easily subjected to unwarranted harassment and abuse” and was ignorant of the facts at issue).

Opposer did not identify President Dunn as a person with relevant knowledge. Opposer has offered three witnesses: Douglas Colber, Esq., Vice-President, Assistant Secretary and Legal Counsel; Sherry Campbell, Trademark Manager; and Mitchell T. Engel, Chief Marketing Officer³, as persons with knowledge relevant to these proceedings. In addition, Opposer willingly identified Mr. Engel as the appropriate person in response to a Rule 30(b)(6) deposition noticed by Applicant.

³ Ms. Campbell and Mr. Colber were identified in response to Applicant’s interrogatories. Ms. Campbell is now with the ServiceMaster Clean business unit. Mr. Colber is no longer employed by Opposer. Mr. Engel’s deposition was conducted on November 10, 2004.

Despite Opposer's offers to make knowledgeable witnesses available, at present, Applicant has failed to exhaust less intrusive discovery methods before trying to go directly "to the top" to depose President Dunn. In fact, Applicant has taken one Rule 30(b)(6) deposition, and no deposition of a ServiceMaster employee has been noticed.⁴ Clearly, Applicant is engaging in a discovery tactic and pattern intended for harassment and warranting a protective order. *See Salter v. Upjohn Co*, 593 F.2d 649 (5th Cir. 1979)(issuing a protective order to stop the deposition of an executive where the noticing party had not proceeded with the deposition of other employees whom the movant had offered as those with knowledge of the relevant facts).

Additionally, Applicant can make no showing that Opposer's related company's top executive, President Dunn, has unique or specialized knowledge of the relevant facts. Mr. Engel, Chief Marketing Officer of The ServiceMaster Company, has personal knowledge of the facts set forth in his Declaration attached hereto as Exhibit D. In his Declaration, Mr. Engel states that it is his belief that the named deponent, President Dunn, does not possess unique or superior knowledge of the (1) the ownership of federal registrations and common law rights in the SERVICEMASTER marks; (2) The ServiceMaster Company's enforcement of its exclusive rights to use the SERVICEMASTER marks; (3) the goods and services offered by The ServiceMaster Company under the SERVICEMASTER marks; (4) the marketing or advertising of Opposer's goods and services under the SERVICEMASTER marks; (5) the channels of trade or the intended consumers for the goods and services offered under the SERVICEMASTER marks; or (6) the topics identified in Applicant's Rule 30(b)(6) deposition notice. *See Engel Decl.* attached as Exhibit D. Accordingly, Applicant should be required to proceed with the deposition of Mr. Engel before seeking to harass one of Opposer's highest-ranking executives.

⁴ In contrast, Opposer has deposed the General Manager, Vice-President, and a Rule 30(b)(6) representative of UGI HVAC Enterprises, Inc., the appropriate subsidiary of UGI Corporation.

Finally, in Applicant's refusal to agree to forego the deposition of Dunn, Applicant's counsel took the position that it could notice additional depositions of unidentified witnesses, of its choosing, in Philadelphia, Pennsylvania (where Applicant's counsel's firm is located).

Applicant's counsel wrote:

To the extent [that Mr. Engel] is unable to testify fully regarding issues involving the provision and branding of services of these two companies, we will notice the depositions of other witnesses for their appearance in Philadelphia.

(See Exhibit C).

Discovery depositions of natural persons within the United States shall be taken in the Federal judicial district where the person resides or is regularly employed, unless the parties agree otherwise. TBMP § 404.03(6). Applicant may not unilaterally notice the discovery deposition of any of Opposer's employees who are not located in Philadelphia for Philadelphia, simply for the convenience of Applicant's counsel, and any threat to proceed in such a manner amounts to an inappropriate discovery tactic.

CONCLUSION

Both the Federal Rules of Civil Procedure and the Trademark Rules of Practice vest in the Board discretion to grant a protective order in order to manage the discovery procedures available to the parties and prevent abuse of those procedures. The supporting Declaration of Mr. Engel constitutes particular and specific evidence that AMS President Ed Dunn is not an appropriate deponent. Opposer therefore is entitled to a protective order under the applicable legal test to prevent the depositions of President Dunn from proceeding and to prevent Applicant from noticing depositions in Philadelphia of witnesses located elsewhere contrary to Trademark Rules of Practice.

If, after taking all other depositions, Applicant is still not satisfied with the information obtained, this issue may be entertained by the Board at a later time.

Opposer's counsel states, under penalty of perjury under the laws of the United States, that he has made a good faith effort to resolve the issues presented in this motion and has been unable to reach an agreement with Applicant's counsel prior to resorting to the Board pursuant to Trademark Rule 2.120(f).

Respectfully submitted,

THE SERVICEMASTER COMPANY

By:


P. Jay Hines
Amy Sullivan Cahill
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314
(703) 413-3000
fax (703) 413-2220
e-mail: tmddocket@oblon.com

Date: December 16, 2004

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **OPPOSER'S MOTION FOR PROTECTIVE ORDER TO PREVENT DISCOVERY DEPOSITIONS OF PRESIDENT ED DUNN** was served on counsel for Applicant, this 16th day of December, 2004, by sending same via First Class mail, postage prepaid, to:

Barbara L. Delaney, Esquire
Vincent V. Carissimi, Esquire
PEPPER HAMILTON LLP
3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, Pennsylvania 19103-2799

Keran A. Eubanks

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

THE SERVICEMASTER COMPANY, :

Opposer/Petitioner, :

Opposition No.: 91/125,743
Appln. Serial No. 76/237,328

v. :

Opposition No.: 91/152,104
Appln. Serial No. 76/166,568

UGI HVAC ENTERPRISES, INC. :

Cancellation No. 92/041,147
Registration No. 2,591,190

Applicant/Respondent. :

APPLICANT/RESPONDENT'S NOTICE OF DEPOSITION OF ED DUNN

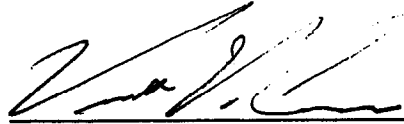
PLEASE TAKE NOTICE that pursuant to Rule 30 of the Federal Rules of Civil Procedure, and Trademark Rules 2.120, UGI HVAC Enterprises, Inc. ("Applicant/Respondent"), by and through its counsel, will take the deposition upon oral examination of Ed Dunn, AMS Business Unit Leader of The ServiceMaster Company ("Opposer/Petitioner").

The deposition will begin at 2:30 p.m. on October 28, 2004, at the law offices of Lord, Bissell & Brook, 115 S. LaSalle Street, Chicago, Illinois 60603, or at such other place as may be agreed upon in writing by counsel for the parties. This deposition will be conducted before an officer authorized to administer oaths and will continue for day to day until completed. The testimony at this deposition will be recorded by stenographic and/or videographic means.

DOCKET NO:	22479745
DOCKETING:	KR 10/15/04
DEPT. DKT:	SS
DUE DATE:	10/28/04 2:30
RETURN TO:	Atty. Summerhill

Deposition of Ed Dunn

You are invited to attend and cross-examine the witness.



Vincent V. Carissimi
Barbara L. Delaney
PEPPER HAMILTON LLP
3000 Two Logan Square
Eighteenth & Arch Streets
Philadelphia, PA 19103-2799
(215) 981-4194

Dated: October 8, 2004

Attorneys for Applicant/Respondent
UGI HVAC ENTERPRISES, INC.

CERTIFICATE OF SERVICE

I certify that on October 8, 2004, I caused a true and correct copy of the foregoing Notice of Deposition of Ed Dunn to be served via facsimile and first class mail, upon the following:

P. Jay Hines, Esquire
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314



NATHAN W. DEAN

EXHIBIT B



ATTORNEYS AT LAW

P. JAY HINES
(703) 412-7028
JHINES@OBLON.COM

October 21, 2004

Via Facsimile and UPS Courier

Vincent V. Carissimi, Esquire
PEPPER HAMILTON LLP
3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, Pennsylvania 19103-2799

Re: *The ServiceMaster Company v. UGI HVAC Enterprises, Inc.*
Opposition Nos. 125,743 & 152,104; Cancellation No. 41,147
Marks: SERVICEMARK HEATING COOLING PLUMBING
& DESIGN and SERVICEMARK
Our Ref: 224797US-244183-36

Dear Vinny:

We are in receipt of your October 8, 2004 letter and enclosed notices to take the depositions of Ed Dunn and Mark Burel.

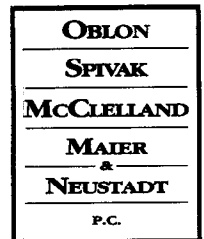
Messrs. Dunn and Burel are the Presidents of American Mechanical Services ("AMS") and American Residential Services ("ARS") respectively. Mr. Dunn and Mr. Burel, as senior executives, do not have unique knowledge of the facts at dispute in this proceeding. It is our client's position that the noticed depositions will serve merely to embarrass and harass Opposer, and that the discovery sought is available to UGI through less intrusive methods.

As we discussed earlier today, Opposer will offer as a substitute witness, Mitchell T. Engel, Chief Marketing Officer of The ServiceMaster Company, both in his individual capacity and in his capacity as a Rule 30(b)(6) representative. Our client is working to confirm Mr. Engel's availability for deposition on October 27, 2004 and we will pass this information along to you as soon as we receive it.

You repeat your client's request for documents relating to the *ServiceMaster Industries, Inc. v. Collman Industries, Inc.* case decided in the early 1970s. We have informed you that The ServiceMaster Company does not maintain copies of documents, publicly available or otherwise, that were generated in connection with this thirty year-old proceeding.

You have instructed us to "inquire of [ServiceMaster's previous] counsel immediately" whether these documents are available. The only means we have of identifying counsel for The ServiceMaster Company's predecessor, ServiceMaster Industries, Inc., in the *Collman Industries* case is the published opinion that lists George B. Newitt, Molinare, Allegretti, Newitt & Witcoff,

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and Edward W. Remus of Chicago, Illinois. We no longer find an active listing for this firm, which later became Banner & Witcoff, Ltd., nor for George B. Newitt, who we believe is retired. We believe that Mr. Remus may be practicing with the firm of McAndrews, Held & Malloy, Ltd. in Chicago.

Although we do not concede that the Board would agree that The ServiceMaster Company has control over documents generated over thirty years ago and once maintained by a law firm no longer in existence, we agree to make an inquiry of Mr. Remus and of Banner & Witcoff, Ltd. no later than October 27, 2004, and will advise you of the responses as soon as we receive them.

We now address the alleged deficiencies raised in your October 8, 2004 letter. These deficiencies generally are directed to Opposer's responses to Applicant's Second Set of Interrogatories and Second Requests for Production of Documents and Things.

APPLICANT'S SECOND SET OF INTERROGATORIES

INTERROGATORY NOS. 2, 3, 4, 5, 12, and 14 (SECOND SET)

You state that Opposer failed to answer adequately Interrogatory Nos. 2, 3, 4, 5, 12, and 14 (Second Set), and that the interrogatories seek relevant evidence relating to (1) actual confusion; (2) the use or lack of use of Opposer's marks with the relevant services; and (3) the nature and extent of use of Opposer's marks, including the SERVICEMASTER mark, and the ARS mark and the AMS mark with the relevant services.

Although the issue of actual confusion is not the subject of any of the identified interrogatories, Opposer has directly responded to Applicant's inquiries regarding actual confusion evidence. *See* Responses to Applicant's Requests for Admission Nos. 1 and 2 and Answers to Applicant's Interrogatory Nos. 13 and 14 (First Set). There is no additional information to provide at this time.

Opposer also has responded adequately to Applicant's questions regarding the manner and extent of use of Opposer's SERVICEMASTER mark, including the renown of Opposer's SERVICEMASTER mark, and has produced numerous documents in response thereto. *See* Answers to Applicant's Second Set of Interrogatories No. 1, 2, 3, 4, 5, 8, and 12, and Answers to Applicant's First Set of Interrogatories 2(a),(b), 6, 7, 8, 11, and 18 and Opposer's documents identified as SVM0216-SVM0229 and SVM00701-SVM00762 (web site print outs); SVM0230-SVM0237 and SVM380-SVM0696 (brochures); and SVM00697-SVM00700 (advertisements). Opposer is producing herewith a listing of ARS and AMS and Rescue Rooter locations, and additional marketing materials recently located by Opposer to supplement the current production.

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We maintain our objection that the ARS and AMS marks are not at issue in this proceeding. Therefore, inquiries regarding the extent of use, or non-use, of the ARS or the AMS mark, are beyond the scope of the pleadings and are irrelevant to claims or defenses of any party in this proceeding, and not reasonably calculated to lead to the discovery of admissible evidence. We refer to the Definitions and Instructions included in Opposer's discovery requests defining "Opposer's Mark" as "Registration Nos. 1,220,269 and 1,272,228, and the corresponding common law rights afforded by use thereof as asserted by Opposer in Count I of its Notice of Opposition." If you are relying on a case, treatise, or other authority to support your position that evidence of use of Opposer's ARS and AMS marks is relevant to this proceeding, please provide it.

INTERROGATORY NO. 7 (SECOND SET)

You repeat your general objections to our answers to the interrogatories listed above, but state that we did not adequately answer Interrogatory No. 7 regarding Opposer's (1) use or lack of use and relative strength of Opposer's mark and (2) the nature and extent of use to which Opposer puts its marks, including the SERVICEMASTER mark, the ARS mark, and the AMS mark, in connection with the relevant services.

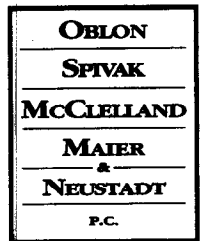
Again, we refer you to the specific answers provided in response to Applicant's first and second sets of written discovery. *See* Answers to Applicant's Second Set of Interrogatories No. 1, 2, 3, 4, 5, 8, and 12, and Answers to Applicant's First Set of Interrogatories 2(a),(b), 6, 7, 8, 11, and 18 and documents identified as SVM0216-SVM0229 and SVM00701-SVM00762 (web site print outs); SVM0230-SVM0237 and SVM380-SVM0696 (brochures); and SVM00697-SVM00700 (advertisements) for evidence of the nature and extent of use of Opposer's SERVICEMASTER mark.

Opposer produces herewith a list of ARS and AMS locations and additional marketing materials recently located by Opposer to supplement current production. We repeat our objection with respect to the ARS mark and the AMS mark, which are not at issue in this litigation.

Finally, we direct you specifically to the Answer to Applicant's Interrogatory No. 5 (First Set) and to documents identified as SVM0001-SVM0181 for information directly responsive to this interrogatory.

INTERROGATORY NOS. 9 and 10 (SECOND SET)

Upon information and belief, there is no information or document in Opposer's possession custody or control that relates to the original decision to adopt and/or use Opposer's



SERVICEMASTER mark, which decision was made more than fifty years ago. To the extent that documents or information may have existed at one time, such items can no longer be located. Opposer refers to its brochure entitled "*The Servicemaster Consumer Chronicle*" previously produced and identified as SVM0237 for information relating to the original meaning or connotation Opposer's SERVICEMARK mark.

OPPOSER'S SECOND SET OF REQUESTS FOR PRODUCTION

REQUEST NO. 1 (SECOND SET)

You state that Opposer has failed to produce responsive documents that are reasonably calculated to lead to the discovery of admissible evidence showing: (1) Opposer's use or lack of use of its mark; (2) the relative strength of Opposer's marks within the fields of residential HVAC, commercial HVAC and other areas; and (3) documents relating to the nature and extent to which Opposer uses its marks, including the SERVICEMASTER mark, the ARS mark, and the AMS mark.

Opposer has produced documents relevant to its use of the SERVICEMASTER mark and to the relative strength of its mark in connection with the relevant services. It also previously produced documents responsive to your requests directed to the nature and extent of the use of Opposer's SERVICEMASTER mark. These documents include information relating to the use of the SERVICEMASTER mark within the fields of residential HVAC services, commercial HVAC services, and other areas. See SVM0216-SVM0229 and SVM00701-SVM00762 (web site print outs); SVM0230-SVM0237 and SVM380-SVM0696 (brochures); and SVM00697-SVM00700 (advertisements). Opposer will produce additional marketing materials recently located by Opposer to supplement current production in the near future. Opposer repeats its objection with respect to the ARS and AMS marks, which are not at issue in this proceeding.

REQUEST NO. 2 (SECOND SET)

Opposer is aware of no document responsive to this request. To the extent that responsive documents existed at one time, they no longer can be located.

REQUEST NO. 3 (SECOND SET)

Opposer refers again to its brochure entitled "*The Servicemaster Consumer Chronicle*" previously produced and identified as SVM0237 for information relating to the meaning and connotation Opposer's SERVICEMARK mark.



REQUEST NO. 4 (SECOND SET)

Opposer refers to its previously produced annual reports for the years 1998-2003 (SVM0238-SVM0330 and SVM00763A-SVM00954) for information relating to Opposer's corporate organization and structure. We also will produce internal corporate organizational charts subject to the restriction that they be limited to "attorneys' eyes only".

REQUEST NO. 6 (SECOND SET) and PRIVILEGE LOG

We produce herewith Opposer's Privilege Log of documents withheld from production on the basis of attorney-client privilege and work product doctrine. This log includes privileged correspondence and attorney work product materials relating to the current TTAB consolidated proceeding.

We now turn to the alleged deficiencies raised in your letter of August 22, 2004 that refers to Applicant's First Set of Interrogatories and First Request for Production of Documents propounded on Opposer.

DOCUMENT REQUEST NO. 9, INTERROGATORY NO. 10 (FIRST SET)

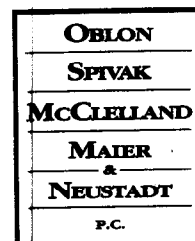
Our client does not maintain documents, publicly available or otherwise, relevant to the opposition against Servpro Industries, Inc., Opp. No. 59,658. Neither does The ServiceMaster Company maintain records that would inform it of who served as outside counsel in this opposition proceeding initiated before the Trademark Trial and Appeal Board in 1970. Accordingly, Opposer has no information or documents in its possession, custody or control that are responsive to Applicant's Request No. 9 (First Set) or Applicant's Interrogatory No. 10 (First Set).

INTERROGATORY NO. 21 (FIRST SET)

Opposer has identified, within reason, all persons who provided information supporting the facts set forth in this Opposition. These persons are Sherry Campbell, Trademark Manager, Legal Department and Cristen Kogl, Esquire, Vice President and Deputy General Counsel – Corporate. See Answer to Applicant's Interrogatory No. 15 (Second Set) and Answer to Applicant's Interrogatory No. 21 (First Set). In addition, Mitchell T. Engel, Chief Marketing Officer, provided information supporting the facts set forth in this Opposition.

DOCUMENT REQUEST NOS. 2, 3, 4, 11, 19, 20 (FIRST SET)

Opposer is not withholding from production any otherwise responsive, non-privileged documents on the basis of confidentiality.



Opposer produces herewith a Privilege Log identifying responsive documents withheld from production on the basis of attorney-client privilege or attorney work-product doctrine.

DOCUMENT REQUEST NO. 6 (FIRST SET)

Your request seeks "documents that disclose the channels of trade through which Opposer offers or intends to offer any goods or services under the SERVICEMASTER marks." Opposer has produced a representative sampling of documents that reflect the channels of trade through which Opposer offers its goods and services under the SERVICEMASTER MARK including, for example, Internet web pages. The production of a representative sampling is appropriate because compliance with a request to produce all such documents (which Applicant's request does not specify) would be unduly burdensome given the number of consumer services Opposer has offered during its business history that spans a period of over fifty years.

DOCUMENT REQUEST NOS. 2, 4, 5, 7, 8, 14, 16 – 19 (FIRST SET)

You seek to amend Applicant's Document Requests Nos. 2, 4, 5, 7, 8, 14, and 16-19 in your August 22, 2004 letter. Your attempt to re-draft these requests to identify particular documents by means of informal correspondence is not proper. Please re-serve the amended discovery requests if you wish for Opposer to respond formally to the amended requests.

DOCUMENT REQUEST NO. 10 (FIRST SET)

Applicant's Document Request No. 10 seeks "samples of all forms of packaging, containers, tags, labels, flyers, advertisements, catalogs, brochures, decals, imprints and any other goods or materials bearing the SERVICEMASTER marks or used in connection with the SERVICEMASTER marks." Your subsequent request that Opposer now additionally confirm that the samples produced include sample advertisements demonstrating use of Opposer's marks "in connection with Opposer's HVAC and plumbing business(es) in all geographic regions where such business is conducted" exceeds the scope of the original request and constitutes an additional interrogatory. Please serve you request for information as a separate interrogatory if you wish for us to respond formally. Opposer reserves its right to object to future interrogatories on the basis that they exceed seventy-five in number.

DOCUMENT REQUEST NO. 11 (FIRST SET)

Opposer has produced all non-privileged documents evidencing the circumstances under which Opposer first became aware of Applicant's SERVICEMARK HEATING COOLING PLUMBING & DESIGN trademark, namely Opposer's documents identified as SVM0342-

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SVM0343 (pages from the December 25, 2001 *Official Gazette* showing publication of federal trademark applications.) Opposer produces herewith a Privilege Log reflecting otherwise responsive privileged correspondence withheld from production.

INTERROGATORY NO. 5 (FIRST SET)

We confirm that The ServiceMaster Residential/Commercial Services Identification Manual bearing production numbers SVM0001-SVM0181 is the only written stylization manual concerning the use of the SERVICEMARK marks.

We turn now to your letter dated August 30, 2004, that supplements objections raised by letter of August 22, 2004.

DOCUMENT REQUEST NO. 9, INTERROGATORY NO. 10 (FIRST SET)

See the above discussion relating to documents relating the SERVPRO & Design opposition. No such documents are in the possession, custody, or control of Opposer.

INTERROGATORY NOS. 11, 18 (FIRST SET)

To the extent you attempt to redraft Applicant's original Interrogatory Nos. 11 and 17, we ask that you serve corrected interrogatories in accordance with procedures afforded by the TBMP and Trademark Rules of Practice. Opposer reserves the right to objection to additional interrogatories on the basis that they exceed seventy-five in number.

I hope that the forgoing resolves the issues you have raised with respect to our client's discovery responses in this matter. We believe that our client has proceeded in good faith and has produced available responsive information and documents in an organized and timely manner. I trust that you will contact me should you have further questions.

Sincerely yours,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



P. Jay Hines

PJH/ASC/kae/cds {I:\atty\PJH\ServiceMaster\244183-224797US-ltr8.doc}

Enclosure(s): Opposer The ServiceMaster Company's Privilege Log
Document Nos. SVM00955-SVM00966

EXHIBIT C

3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, PA 19103-2799
215.981.4000
Fax 215.981.4750

RECEIVED
NOV 02 2004

OBLON, SPIVAK, MCCLELLAND
MAIER & NEUSTADT, P.C.

Hines
JK

Vincent V. Carissimi
direct dial: 215.981.4351
direct fax: 215.689.4625
carissimiv@pepperlaw.com

November 1, 2004

Via Facsimile and First Class Mail

P. Jay Hines, Esquire
Oblon Spivak McClelland Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

Re: *The ServiceMaster Company v. UGI HVAC Enterprises, Inc.*
Opposition Nos. 152,104 & 125,743; Cancellation No. 41,147

Dear Jay:

This will confirm the 30(b)(6) deposition of ServiceMaster on November 10, 2004. We will send you a revised notice tomorrow.

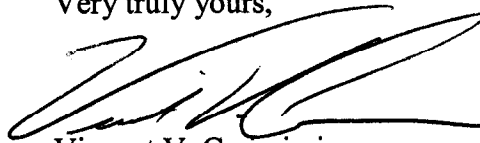
You have informed me that The ServiceMaster Company continues to refuse to produce Mark Burel and Ed Dunn as requested by the October 8, 2004 Notices of Deposition. I have informed you that I wanted to make one trip to depose ServiceMaster witnesses and was dubious as to whether Mr. Engel's testimony would suffice.

As I explained to you in our telephone conversation, we cannot acquiesce in your refusal to produce these witnesses. You have mentioned that Mitch Engel, who you are producing both in his individual capacity as well as The ServiceMaster Company's 30(b)(6) witness, will be able to provide all relevant information regarding ARS/Rescue Rooter and AMS. To the extent he is unable to testify fully regarding issues involving the provision and branding of services of these two companies, we will notice the depositions of other witnesses for their appearance in Philadelphia. It seems implausible that Mr. Engel, no matter how well prepared, will be able to testify fully as to all of the subject matters listed in the 30(b)(6) notice as well as relevant matters within the knowledge of Messrs. Ward, Burel and Dunn.

P. Jay Hines, Esquire
November 1, 2004
Page 2

Please be advised, therefore, that my attendance at the 30(b)(6) deposition on November 10, 2004 does not waive any rights with respect to any of the other depositions we have noticed.

Very truly yours,

A handwritten signature in black ink, appearing to read "Vincent V. Carissimi", with a stylized, flowing script.

Vincent V. Carissimi

VVC/lsn

EXHIBIT D

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THE SERVICEMASTER COMPANY,)	Opposition No.: 125,743
)	Appln. Serial No. 76/237,328
)	
Opposer,)	Opposition No.: 152,104
)	Appln. Serial No. 76/166,568
v.)	
)	Cancellation No. 92/041,147
UGI HVAC ENTERPRISES, INC.,)	Registration No. 2,591,190
)	
Applicant.)	
)	

DECLARATION OF MITCHELL T. ENGEL

1. I, Mitchell T. Engel, am over eighteen years of age, of sound mind, and have personal knowledge of the facts stated herein.
2. I am employed as Chief Marketing Officer for The ServiceMaster Company, the Opposer in the above captioned proceeding, and have been so employed for the past two years and seven months.
3. The ServiceMaster Company owns rights in the SERVICEMASTER marks of U.S. Registration Nos. 1,220,269 and 1,272,228 ("the SERVICEMASTER marks").
4. In my role as Chief Marketing Officer, I am personally familiar with the following subject matter regarding the SERVICEMASTER marks:
 - a. The ServiceMaster Company's common law rights in the SERVICEMASTER marks;
 - b. The use of the SERVICEMASTER marks by its business units;


- c. The goods and services offered by The ServiceMaster Company under the SERVICEMASTER marks;
- d. The ServiceMaster Company's marketing and advertisement of goods and services under the SERVICEMASTER marks;
- e. The channels of trade and the intended consumers for the ServiceMaster Company's goods and services offered under the SERVICEMASTER marks; and
- f. The topics identified in the Applicant's Rule 30(b)(6) Notice to Take Deposition and Exhibit thereto.

5. I believe that there are other persons with equal or greater knowledge of the information identified above and I do not believe that AMS President Ed Dunn has unique or superior knowledge of the information identified above.

I declare under penalty of perjury under the laws of the United States that the foregoing is true to the best of my knowledge, information and belief.

Date: 12/8/01

By:



Mitchell T. Engel
Chief Marketing Officer
The ServiceMaster Company

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